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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/921,061	08/01/2001	Erwin Karl Meimer	TTLRCL.001A	6174
20995	7590	10/04/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			CHRISTMAN, KATHLEEN M	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			3713	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,061

Applicant(s)

MEIMER, ERWIN KARL

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-11 and 14-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

In response to the request for continued examination and amendment filed 08/24/2004; claims 1-11 and 14-36 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/24/2004 has been entered.

Response to Amendment

1. The affidavit filed on 08/24/2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Vaughn reference. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Vaughan, Jr reference.

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. Such evidence has not been submitted. The mere listing of the program files stored on the CD-ROMs, as in exhibit D. (the examiner notes that the files listed in the printout do not completely match the file listing of the submitted CD-Rom) does not demonstrate how they function to perform the claimed system and method. The evidence submitted in exhibits A-C merely show proof that two shipments of a product called "Marketing Masterfully" were sent to and paid for by Pt. Loma Nazarene University Bookstore, with shipping dates of October 28, 1999 and November 22, 1999. Exhibit E is asserted to be a "true reproduction" of this software product. However, the evidence does not fully support this assertion. Firstly, the version date on the CD itself is November 20, 1999. This only matches the second of the two shipment dates. As such the first of the shipments asserting a reduction

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to practice by October 28, 1999 is not supported. Next, there are files on the CD-Rom, which have creation/modification dates as late as January of 2000. As it is impossible for the examiner to know the functionality of these files and whether they are critical to the operation of the product, the examiner cannot afford the date of November 1999 to the system. The examiner notes that the file folders show 2004 dates. However, such is considered acceptable as the creation of such folders is considered necessary in order to reproduce the software. Lastly, the evidence submitted, including the CD-Rom, does not show that the system functions in the manner claimed. For example, it is not readily apparent that the system randomizes the questions in a level prior to presentation, or that the learning levels have specific retest times associated with them. Exhibit F does not clarify these issues. As such the applicant has failed to show the CD-Rom entitled "Marketing Masterfully" is a reduction to practice of the currently claimed invention.

Even should applicant be capable of proving the prior reduction to practice, the Vaughan, Jr reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention of claims 4 and 33. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention. See MPEP Chapter 2300 for information on initiating interference proceedings.

Regarding the second affidavit of Erwin Karl Meimer, the evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Vaughan, Jr reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Although the affidavit asserts that conception of a new learning process was disclosed in the presentation of the inventors master thesis there is no supporting documentation that this learning method corresponds to the now claimed invention. Should such evidence be provided the applicant would still be required to show due diligence up to the time of reduction to practice of the invention or effective filing date of the instant application.

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Further the examiner notes that the assertion that the content of this presentation was subject to confidentiality is unsupported. The section of the student code provided merely shows that a student is expected to acknowledge the personal privacy of other students. The section specifically states that the confidentiality is related to information about one's employer, other students, or their employers. There is no assertion that the content of a master's presentation is considered confidential.

The affidavit of Dr. Timothy Becker references application number 09/821061, not the instant application number. Presuming this is a typographical error the affidavit fails to show enough evidence to support that the use of the "Marketing Masterfully" program was experimental, further details are addressed below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-3 and 16-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.** The preamble of each of the claims recites "a system", with the exception of claim 33, which recites "a program storage device storing instructions that when executed perform the steps...". The system claims recite generally a plurality of "modules" or are written in means plus function language. The only means or modules disclosed in the specification are software components. Thus the claims are drawn to computer programs per se. As the computer programs are not embodied on a tangible medium they are drawn to non-statutory subject matter. Regarding claim 33, the claim is also drawn to computer program per se as the "program storage device" is not in operative

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communication with a computer system capable of executing the program stored thereon. Applicant is direct to MPEP §2100 for guidance on claiming computer program products.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 4 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Vaughan, Jr. (US 6419496 B1, herein after Vaughan).** Vaughan teaches an educational system and method which can be interpreted as the testing system of the claimed inventions. Vaughan teaches selecting a set of questions to be made available to a user, wherein each of the questions has an associated learning level (P-Level) and a retest time interval (L-level) that indicates a period of time that must pass between presentation of a respective question (number of session before an item is presented again); selecting one of the available questions from the set; testing the user with the selected question; determining whether the user answered the selected question correctly; if the user answered the selected question correctly, increasing the retest time interval to be greater than the current retest time interval for the selected question in Figure 4.

4. **Claims 1-11 and 14-36 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.** The affidavit of Dr. Timothy Becker admits to a sale of the invention during the spring

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1999 semester at San Diego State University. An impermissible sale has occurred if there was a definite sale, or offer to sell, more than 1 year before the effective filing date of the U.S. application and the subject matter of the sale, or offer to sell, fully anticipated the claimed invention or would have rendered the claimed invention obvious by its addition to the prior art. *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562, 1565, 33 USPQ2d 1512, 1514 (Fed. Cir. 1995). The on-sale bar of 35 U.S.C. 102(b) is triggered if the invention is both (1) the subject of a commercial offer for sale not primarily for experimental purposes and (2) ready for patenting. *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 67, 48 USPQ2d 1641, 1646-47 (1998).

There is no doubt that a sale occurred. Therefore the only issue is if the sale was for experimental purposes. There is no assertion made in the affidavit that the student's knew they were purchasing the product for the purposes of an experiment. There were no confidentiality requirements made on the product. The product was reduced to practice, evidenced by the sale of a CD-Rom, and is based upon the currently claimed systems and methods. Although the applicant asserts that there are supposed improvements made to the product (electronic transmission of score sheets, randomization, and adjustments to the software algorithm) the underlying function of the product did not change. With the exception of the randomization feature, added to claims 1, 3, 5, 16, 21, 32, 34, and 35 with the currently filed amendment, these features are not presented in the claims as now pending. The applicant has shown no evidence to support that these features did not exist in the sold product, but merely makes assertions. Further each of these features are all obvious in view of the prior art (Ho et al). Applicant has failed to show sufficient evidence that the sale was primarily for experimental purposes or that the product sold was not ready for patenting. The preponderance of the evidence shows a product, which is fully encompassed by the pending claims, was sold more than 1 year before the effective filing date of the U.S. Application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. **Claims 1-3, 5-11, 14-32, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vaughan, Jr. (US 6419496 B1) in view of Ho et al (US 6212358 B1).** Vaughan teaches an educational system and method which can be interpreted as the testing system of the claimed inventions. Vaughan teaches selecting a set of questions to be made available to a user, wherein each of the questions has an associated learning level (P-Level) and a retest time interval (L-level) that indicates a period of time that must pass between presentation of a respective question (number of session before an item is presented again); selecting one of the available questions from the set; testing the user with the selected question; determining whether the user answered the selected question correctly; if the user answered the selected question correctly, increasing the retest time interval to be greater than the current retest time interval for the selected question (as per claims 1-3, 5, 16, 18, 19, 21, 28, 31, 32, 34 and 35); and if the user answered the selected question incorrectly, decreasing the retest time interval to be less than the current retest time interval for the selected question (as per claims 5, 13, 17, and 29), in Figure 4. If a user answers a question incorrectly, moving the question into a level designated for missed questions (claims 6 and 22), is shown as the P=0 level of Vaughan, this level is also the second lowest level (claims 8 and 24). If there are no "unseen items" this is also the lowest learning level (claims 7 and 23). Otherwise, the lowest level contains questions that have not been previously presented to the user (claims 9 and 25) is referred to as the "unseen items" or P=-1 level by Vaughan. If a user answers a selected question incorrectly, moving the selected question into the next lowest learning level (claims

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10, 21, 26, and 36) is shown as reference 18 of Figure 4. Reference 19 of Figure 4, teaches if a user answers a selected question incorrectly maintaining the selected question at the selected learning level until the question is answered correctly, as in **claims 11 and 27**. Presenting the questions in sequence based at least in part upon the ordering of the learning levels, as in **claims 15 and 21**, is taught at col. Col. 10: 20-30.

Vaughan teaches all aspects of the claimed invention as shown above except the testing module ceasing to ask a question (**claims 1, 2, 19, and 31**); if the selected question is answered correctly, the testing module determines whether the time interval is increased past a predefined threshold (**claim 18**); the randomization of questions (newly added to **claims 1, 3, 5, 16, 21, 32, 34 and 35**). Ho et al teaches these features in Figures 7 and 9, and their associated text and further teaches randomization of questions in at least col. 6:18-23. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the removal of questions, as taught by Ho et al, into the Vaughan, Jr. reference so as to remove items that a user no longer needs to review.

Response to Arguments

6. The only arguments presented in the application are drawn to the submission of affidavits swearing behind the Vaughan, Jr reference. As these affidavits are deemed sufficient the arguments are moot.

Conclusion


This action is made non-final in view of the new grounds of rejection under 35 USC §101.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M. Christman
September 24, 2004


XUAN M. THAI
PRIMARY EXAMINER
TC 3713
GAM